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\*1 THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

Board of Patent Appeals and Interferences

Patent and Trademark Office (P.T.O.)

EX PARTE GUNTER BOUILLON

Appeal No. 95-1215

Application No. 07/750,777 [FN1]

HEARD: January 16, 1998

Sprung, Kramer, Schaefer &amp; Briscoe

660 White Plains Road

Tarrytown, NY 10591-5144

Before KIMLIN, PAK and WALTZ

Administrative Patent Judges.

PAK

Administrative Patent Judge.

## DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 11 through 21, which are all of the claims pending in the application.

Claims 11, 19, 20 and 21 are representative of the subject matter on appeal and read as follows:

11. An anhydrous skin cleansing agent comprising by weight 0.7 to 94.7% of a surfactant, 5 to 99% of an organic solvent and water-insoluble abrasive as active components and 0.3 to 55% of a water-swellable organic polymer as both a soil carrier and abrasive, the organic solvent comprising a member selected from the group consisting of an ester, wax, oil, terpene and mixtures thereof.

19. A skin cleansing agent according to claim 11, wherein the water-swellable organic polymer is the only abrasive and the particle size of the water-swellable organic polymer is less than 1,000 0m.

20. A skin cleansing agent according to claim 11, wherein the agent includes a second abrasive in addition to the water-swellable organic polymer, and the particle size of the water-soluble organic polymer is less the 200 0m.

21. In the cleansing of the skin wherein a skin cleansing agent and water are applied to the skin, the improvement which comprises employing as the skin cleansing agent an agent according to claim 11.

The references relied on by the examiner are:

Oneto et al. (Oneto)	4,130,497	Dec. 19, 1978
Dawson	4,537,604	Aug. 27, 1985

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Schafer et al. (Schafer) 4,612,352 Sep. 16, 1986

The appealed claims stand rejected as follows [FN2]:

- (1) Claim 21 under 35 U.S.C. § 101 as being "directed to an intended use";
- (2) Claims 12, 14, 17, 19 and 20 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as his invention; and
- (3) Claims 11 through 21 under 35 U.S.C. § 103 as being unpatentable over Oneto in view of Schafer and Dawson.

We have carefully reviewed the entire record before us, including all of the arguments and comments advanced by the examiner and appellant in support of their respective positions. This review leads us to conclude that only the examiner's § 112 rejection of claims 19 and 20 is well-founded. Accordingly, we will sustain only the § 112 rejection of claims 19 and 20, but will reverse the remaining rejections based on § 101, § 112 and § 103. Our reasons for this determination follow.

\*2 The examiner has rejected claim 21 under 35 U.S.C. § 101 as being "directed to an intended use." See Answer, page 3. The examiner appears to view the subject matter of claim 21 as nonstatutory in terms of 35 U.S.C. § 101 because the so-called "an intended use" recited in claim 21 is not a process within the meaning of 35 U.S.C. 100 (b). See, e.g., Ex parte Dunkix, 153 USPQ 678, 679 (Bd. App. 1967). 35 U.S.C. § 101 reads in relevant part:

Whoever invents or discovers any new ... process ... may obtain a patent therefore....

The term "process" is defined by 35 U.S.C. § 100(b) as:

... process, art or method, and includes a new use of a known process, machine, manufacture composition of matter, or material.

This definition is interpreted to include:

an act, or a series of acts, performed upon the subject matter to be transformed or reduced to a different state or thing. See In re Schrader, 22 F.3d 290, 295, 30 USPQ2d 1455, 1459 (Fed Cir. 1994), citing *Cochrane v. Deener*, 94 U.S. 780, 787-788 (1877).

Although claim 21 does not use the term "process" or "method", it does recite a skin cleaning process involving a step of applying a novel skin cleansing agent and water to the skin. This applying step is not "an intended use" step as alleged by the examiner. Rather, it is a positive act. Since the examiner has not demonstrated that the above cleaning process involving a positive cleaning step would not transform or reduce the skin, the skin cleansing agent and water into a different state or thing, we find that the examiner's position is untenable. Accordingly, we reverse the examiner's decision to reject claim 21 under 35 U.S.C. § 101.

The examiner has rejected claims 12, 14, 17, 19 and 20 under 35 U.S.C. § 112, second paragraph, as being indefinite. To establish indefiniteness under § 112, the examiner has to establish, in the first instance, that the scope of the appealed claims could not be ascertained by one of ordinary skill in the art, when the specifically criticized language is read in light of the teachings of the prior art and the supporting specification. In re Kroekel, 504 F.2d 1143, 183

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USPQ 619 (CCPA 1974); In re Moore, 439 F.2d 1232, 169 USPQ 236 (CCPA 1971).

Regarding claims 12, 14 and 17, the examiner argues (see Answer, pages 2 and 3) that:

In claims 14, 17 "or" is indefinite in a Markush group using "selected from ..." language.

In claim 14 "(meth-) acrylamide" and "acrylic" ester" are indefinite; are polymers of these monomers intended?

In claim 12 "at least one" is indefinite.

The examiner, however, does not point out why these criticized words would have rendered the scope of the appealed claims unascertainable, particularly when they are read in light of pages 3 and 6 through 14 of the supporting specification. The examiner simply has not met his burden. Thus, we reverse the examiner's decision to reject claims 12, 14 and 17 under 35 U.S.C. § 112, second paragraph.

\*3 Regarding claims 19 and 20, however, they stand on a different footing [FN3]. We agree with the examiner that claims 19 and 20 are indefinite since the scope of dependent claims 19 and 20 cannot be ascertained due to their inconsistencies with their parent claim, claim 11. It is well settled that claims in dependent form are construed to include all the limitations of their parent claim. See 37 CFR § 1.75(c). It follows that dependent claims 19 and 20 encompass not only their specific limitations, but also all the contradicting limitations of claim 11. However, we do not observe, and appellant does not point to, any teaching in the specification which would lead to clarification of these inconsistencies. Accordingly, we affirm the examiner's decision to reject claims 19 and 20 under 35 U.S.C. § 112, second paragraph.

The examiner has rejected claims 11 through 21 under 35 U.S.C. § 103 as unpatentable over the combined teachings of Oneto, Schafer and Dawson. We will not sustain this rejection. While the examiner has pointed to the various individual components of the claimed cleansing agent described in the prior art references, the examiner has not established on this record why one of ordinary skill in the art would have been led to combined the individual components. Specifically, the record is devoid of any evidence or sound scientific reasoning as to why one of ordinary skill in the art would have been led to add a water swellable organic polymer useful for "soil release and antistatic finishing, for reducing the deposition of soil during washing and for hydrophilizing textiles" (see column 7, lines 49-55, of Schafer referred to by the examiner) in Oneto's single liquid phase detergent composition useful as a foam bath product. The examiner's proposed combination, in our opinion, is based purely on impermissible hindsight gained by first having read appellant's disclosure, and not on what the teachings of the prior art references themselves would have fairly suggested to one of ordinary skill in the art. See In re Warner, 379 F.2d 1011, 1016, 154 USPQ 173, 177 (CCPA 1967) (the examiner has the initial duty of supplying the factual basis for his rejection; he may not, because he doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis).

As a final point, we note that appellant acknowledges (see specification, page 1):

Flowable or paste-like skin cleansing agents are generally used to clean

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extremely soiled skin areas, e.g., in the metal-working industry or lacquer and varnish factories. Known skin cleaning formulations, in most cases these are pastes, contain surfactants as detergent surfactant, oleophilic and/or oleophobic solutizer, organic solubilizers, and optionally water. These known products furthermore contain as abrasives sand, wood flour, or plastic powder. These solid substances remove the dirt due to their abrasivity.

\*4 Upon return of this application, the examiner is to determine whether the plastic powder acknowledged to be known includes water-swellable polymer. It appears from page 3 of the specification that water insoluble plastic powders may be water-swellable. If these powders are in fact water-swellable, the examiner must also consider the applicability of a rejection under 35 U.S.C. § 102(b) or § 103.

In summary:

- (1) The rejection of claim 21 under 35 U.S.C. § 101 is reversed;
  - (2) The rejection of claims 12, 14 and 17, 19 under 35 U.S.C. § 112, second paragraph, is reversed;
  - (3) The rejection of claims 19 and 20 under 35 U.S.C. § 112, second paragraph, is affirmed; and
  - (4) The rejection of claims 11 through 21 under 35 U.S.C. § 103 is reversed.
- Accordingly, the decision of the examiner is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

#### BOARD OF PATENT APPEALS AND INTERFERENCES

EDWARD C. KIMLIN

Administrative Patent Judge

CHUNG K. PAK

Administrative Patent Judge

THOMAS A. WALTZ

Administrative Patent Judge

FN1. Application for patent filed August 22, 1991. According to the appellant, the application is a continuation of Application No. 07/466,398, filed July 27, 1990.

FN2. The examiner has withdrawn the remaining rejections. See Answer, pages 1 and 2 and Supplemental Answer, page 3.

FN3. In the event of further prosecution of claims 19 and 20, the examiner is advised to determine whether they do not further limit the subject matter of their parent claim in violation of 35 U.S.C. § 112, fourth paragraph; and 37 CFR § 1.75(c).

APPEAL NO. 95-1215 - JUDGE PAK

APPLICATION NO. 07/750,777

APJ PAK

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APJ KIMLIN

APJ WALTZ

DECISION: AFFIRMED-IN-PART

Typed By: Jenine Gillis

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1st Revision: 23 Feb 98

FINAL TYPED:

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